

Docket No. F-7997

Ser. No. 10/696,876

**REMARKS**

Claims 1 and 9-14 remain pending in this application. Claims 1 and 9-14 are rejected.

Claim 1 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 2,135,210 (J.R. Farrar). To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03.

The Office Action states that Farrar discloses a golf ball with a groove. On page 2, the Office Action admits that Farrar fails to teach the claimed width and depth of the groove. The Office Action states that it would have been obvious, in view of routine optimization, to provide the depth and width of the groove as claimed in claim 1.

The Court of Claims and Patent Appeals has explained that the discovery of an optimum value of a variable is not obvious if the parameter optimized is not recognized to be a result-effective variable. *See In re Antonie*, 195 USPQ 6, 8-9 (CCPA 1977) (emphasis added). The Office Action has provided no documentary evidence to show that the depth and width of the groove, as recited in claim 1, is a result-effective variable. Accordingly, as a matter of law, the depth and width of the groove, as recited in claim 1, is not obvious over J.R. Farrar.

Docket No. F-7997

Ser. No. 10/696,876

Furthermore, even if the Examiner were to demonstrate that the depth and width of the groove is a result-effective variable, *prima facie* obviousness would still not be demonstrated. The purpose of the grooves in J.R. Farrar is to affect the way a golf ball travels while it is in the air while the present invention utilizes the groove recited in claim 1 to affect the way the golf ball travels as it is rolling along the ground. Thus, the optimization of the width and depth of the golf ball in J.R. Farrar would be different than that of the present application because the purpose is different.

Furthermore, claim 1 recites not just a groove, but also a plurality of dimples. J.R. Farrar fails to disclose a golf ball having both a plurality of dimples and a groove. In fact, J.R. Farrar specifically states that having markings on the ball on its entire surface is undesirable. For example, J.R. Farrar teaches, on page 3, second column, lines 5-10 that an ordinary golf ball with markings on its entire surface would make it impossible to change the effectiveness of the air resisting surfaces of the markings on the conventional golf ball. Furthermore, one of the problems identified by J.R. Farrar is golf players causing the ball to curve to the right or left, as disclosed on page 1, first column, lines 23-25 of J.R. Farrar. It is also disclosed in J.R. Farrar that increasing the paddle coefficient of a golf ball causes a tendency of the ball to curve and that the paddle coefficient is related to the roughness of a golf ball, as explained on page 2, first column, line 71 to page

Docket No. F-7997

Ser. No. 10/696,876

2, second column, line 5. Thus, J.R. Farrar seeks to eliminate the curving of golf balls while in the air and discloses that surface roughness increases the curving of golf balls in the air. Thus, J.R. Farrar teaches that excluding dimples is beneficial for the purpose of J.R. Farrar. Thus, J.R. Farrar fails to teach or disclose dimples in combination with a groove, as recited in claim 1. Accordingly, for the above-identified reasons, claim 1 is patentable over the cited art. Claims 9-12 are patentable at least for the reason that they depend from a patentable base claim. See *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claims 9-14 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 2,135,210 (J.R. Farrar) in view of U.S. Patent No. 6,852,039 (Pettigrew et al.). On page 2, the Office Action states that Farrar fails to teach the use of a logo, number, symbol, and slogan printed on the groove and relies on Pettigrew et al. for this teaching.

The Office Action states that because the indicia in the claims of the current application merely depend on the intended use of the device and the desired information to be displayed that it would be obvious to provide such indicia on a golf ball. The Office Action also states that the markings are not functionally related to the golf ball of the current application and that therefore there is no unobvious functional relationship.

Docket No. F-7997

Ser. No. 10/696,876

Pettigrew et al., which was cited by the Examiner, has claims which recite instructions for hitting a golf ball printed on the golf ball. Thus, if information on a golf ball pertaining to the intended use of the golf ball and the desired information to be displayed are per se obvious, then, for example, claim 1 of Pettigrew et al. would be invalid. In fact, the Notice of Allowability of Pettigrew et al., in the section of Allowable Subject Matter, states that the reasons for allowance are that "the prior art does not show or suggest the instructional indicia being text and indicated the point at which the ball should be struck." Applicant respectfully requests that the Examiner explain why the claims in Pettigrew et al. were allowed by the USPTO in light of the Examiner's suggestion that information on a golf ball pertaining to the intended use of a golf ball and the desired information to be displayed is per se obvious. Furthermore, the Office Action provides no evidence that information on a golf ball pertaining to the intended use of a golf ball and the desired information to be displayed is per se obvious and Applicant respectfully requests that the Examiner cite appropriate case law in order for Applicant to provide an appropriate response. Additionally, the Federal Circuit has stated that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *In re Gulack*, 217 USPQ 401, 403 (Fed. Cir. 1983). Thus, one

Docket No. F-7997

Ser. No. 10/696,876

of a logo, number, symbol, and slogan printed on the groove of a golf ball, as recited in claims 9-14 is nonobvious.

Claims 9 and 13 recite at least one of a logo, number, symbol, and slogan on a groove. All of the indicia in Pettigrew et al. are located on the outer surface of the body, as stated in the abstract of Pettigrew et al. There is no suggestion or motivation evidenced in the Office Action for indicia to be on a groove. Furthermore, the location of the indicia on a groove is not dictated by the specific content of the indicia so the Office Action's arguments regarding the content of printed matter are inapposite regarding claims 9 and 13. Moreover, locating the indicia on the groove as opposed to the outer surface of the golf ball will advantageously reduce the wear on the indicia. Accordingly, at least one of a logo, number, symbol, and slogan being on a groove is a functional relationship and is patentable.

Claims 11 and 13 recite at least one of a logo, number, symbol, and slogan being indicative of the width of the groove. An analysis of *in re Gulack*, which was cited by the Office Action, supports the proposition that there is a functional relationship between the golf ball and at least one of a logo, number, symbol, and slogan being indicative of the width of the groove of the golf ball. The court in *In re Gulack* analyzed *In re Miller* and quoted *In re Miller* as stating that "[h]ere is a new and unobvious functional relationship between a measuring *receptacle*,

Docket No. F-7997

Ser. No. 10/696,876

volumetric *indicia*, thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio" and stated that "[t]he court found that the printed matter in Miller's invention was functionally related to the volume measuring device and reversed the rejection." See *In re Gulack*, 217 USPQ 401, 404 (Fed. Cir. 1983). Thus, just as a functional relationship was found between indicia on receptacles pertaining to the volume of the receptacles and the receptacles in *In re Miller* as cited by *In re Gulack*, there is similarly a functional relationship between the golf ball and indicia on the groove of the golf ball pertaining to the width of the groove. The indicia pertaining to the width of a groove is analogous to indicia pertaining to the volume of a receptacle. Thus, as a matter of law, at least one of a logo, number, symbol, and slogan being indicative of the width of the groove in a golf ball as recited in claims 11 and 13 is functionally related to the golf ball and is therefore patentable. None of the cited art discloses or suggests the subject matter of claim 11 and 13 and notice of their patentability is respectfully requested.

Claim 10 recites that one selected from the logo, number, symbol, and slogan can be seen when the golf ball rolls. The cited art fails to disclose or suggest this limitation.

Claim 12 recites that one selected from the logo, number, symbol, and slogan as corresponding to a skill level of a golf player. The cited references fail to disclose or suggest this limitation.

Docket No. F-7997

Ser. No. 10/696,876

Claim 14 recites that the width of the groove is from 1/8 to 1/4 of a diameter of the golf ball. This limitation is not disclosed or suggested in the cited references. Furthermore, the width of the groove as a function of the diameter of the golf ball has not been demonstrated by the Office Action as being a result-effective variable.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

By and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340